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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/414,121	10/08/1999	SCOTT A. STEELE	NSP00012	2811

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EXAMINER

ALVAREZ, RAQUEL

ART UNIT	PAPER NUMBER
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3622

DATE MAILED: 01/21/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/414,121

Applicant(s)

STEEL ET AL.

Examiner

Raquel Alvarez

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 11/13/2002.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-9, 11-17, 19 and 21-27 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9, 11-17, 19 and 21-27 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                  | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____                                    |

### DETAILED ACTION

1. This office action is in response to communication filed on 11/13/2002.
2. Claims 1-9, 11-17, 19 and 21-27 are presented for examination.

#### **Claim Rejections - 35 U.S.C. § 103**

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. **Claims 1- 9 11-17, 19 and 21-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Goldberg et al.(6,183,366 hereinafter Goldberg) in view of Titmuss et al.(WO 98/47295 hereinafter Titmuss).**

In regard to claims 1, 2 and 12 Goldberg teaches providing services in a communication network(Abstract).

Providing a plurality of service options to an end user of a communication device (see figures 8A-8B); providing products or services to said end user in response to a subscription to one of the services options (i.e the user receives Internet services once registered with the Internet provider)(col. 29, lines 7-20); providing advertisements to the end user in lieu of receiving compensation for a subscription (col. 29, lines 7-, col. 30, lines 1-19).

Goldberg do not specifically teach that the advertisements are based on the content received by the wireless communication device. Nevertheless, Titmuss teaches

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that the content (broadcast) that the user can receive or receives on said wireless device depends on the local area that user is in and based on the local area that the end user is in determines the shortlist of information sources to be transmitted to the end user(pages 17 and 18). It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included advertisements based on the content of the received information from the user's device because such a modification would allow the system to filter out information and dynamically alter, thereby providing for personalized information distribution which alters the information delivered dynamically in accordance with the location of the user (in Titmuss page 5) and to implement the invention in a wireless communication device such as Titmuss in order to provide a portable, convenient use of the system.

Claim 9 further recite providing advertisement based upon advertisement acceptance. It is obvious in the marketing and advertisement fields to provide further discounts or incentives to customers that are more likely to use coupons because such a modification would increase the chances that the coupons or incentives would be used.

Claims 13 , 23 and 24 differ from claim 1 in that the advertisements are based on a configuration of the wireless device. Titmuss teaches that content that the user can or receives on said wireless device, e.g. graphics, voice etc. determines the type of advertisement(e.g. voice or image) that would be provided to the user of said device (page 20). It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included advertisements based on the configuration of

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the device because such a modification would allow the system to only send advertisements that correspond to the device's capabilities.

With respect to claim 3, Titmuss teaches that the location related information Includes position (page 9, last paragraph). It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included position in the location related information because such a modification would enable the system to better service the customer based on their position.

With respect to claim 4, Titmuss teaches that the step of providing advertisements comprises providing an advertisement for a predetermined vendor when a subscriber is within a predetermined distance of said predetermined vendor(i.e. when a user is within a predetermined specified location of certain vendors; a service list providing information source descriptions associated with the location of the user )(page 17) . It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included providing an advertisement for a predetermined vendor when a subscriber is within a predetermined distance of the predetermined vendor because such a modification would allow the customer to be aware of the vendors that are close by.

With respect to claim 5, Titmuss further teaches providing advertisements when end user preference corresponds with vendor criteria(i.e. based on the customer's identifying criteria and what the service provider offers(vendor) an individualized package and special tailored to meet the individual needs are presented to the customer)(page 24). It would have been obvious to a person of ordinary skill in the art

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at the time of Applicant's invention to have included advertisements when end user preferences corresponds with vendor criteria because such a modification would allow the system to better target the advertisements.

Claim 6 further recites requiring user interaction to determine whether an advertisement was viewed. Since Goldberg teaches that certain reliability features are included for assuring that the advertisements are presented to the user (col. 30, lines 2-5) then it would have been obvious to a person of ordinary skill in the art to have included requiring user interaction to determine whether an advertisement was reviewed to be considered an advertisement that was provided in lieu of receiving compensation for the service because such a modification would assure the advertiser that the customer is entitled to the compensation.

With respect to claims 7, 8, 15 and 16, Titmuss teaches that the advertisements are based upon a shopping list of said end user and shopping history of the end user (i.e. based on the customer's prior purchasing behavior and the list of things that the customer might purchase, a list of local facility and what they offer is provided to the end user (pages 14 and 19 ). It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included advertisements that are based upon a shopping list of said end user and shopping history of the end user because such a modification would allow the system to better target the advertisements.

Claims 11 and 19 recite providing advertisements at predetermined times based upon user device habits. Since, the combination of Goldberg and Titmuss teach that the personal agent accesses customer database(i.e. user's preference data, including age,

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gender, interests, dynamic update preference, etc.) and retrieves information about customer's preferences to enable the system to provide advertisements based on the customer's preferences (in Titmuss, page 19 ) then it would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included in the user's preference data a predetermined time which would be convenient to the user to receive advertisements based on the user's habits because such a modification would provide the advertisements at a time that would be convenient to the user.

Claim 14 is similar in scope as claim 6 and therefore is rejected under similar Rationale.

Claim 17 is similar in scope as claim 9 and therefore is rejected under similar rationale.

With respect to claims 21, 22, 25 and 26 , Titmuss further teaches that the provision of the advertisement is based upon the determined location of said wireless communication device to a provider of at least one of said products or services (page 17). It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included advertisements based upon the location of said wireless communication device because such a modification would provide a more focused advertisement and convenient advertisement to the user.

With respect to claim 27, the limitations were previously addressed above in the rejection to claims 12 and 13 and therefore is rejected under similar rationale.

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**Response to Arguments**

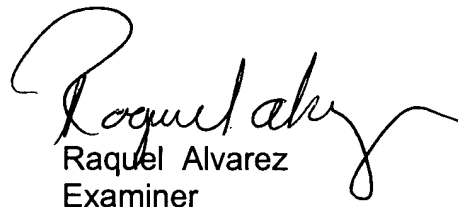
4. Applicant's arguments with respect to claims 11/13/2002 have been considered but are moot in view of the new ground(s) of rejection.

**Point of contact**

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Raquel Alvarez whose telephone number is (703)305-0456. The examiner can normally be reached on 9:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric W Stamber can be reached on (703)305-8469. The fax phone numbers for the organization where this application or proceeding is assigned are (703)872-9326 for regular communications and (703)872-9327 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)308-1113.

  
Raquel Alvarez  
Examiner  
Art Unit 3622

R.A.  
January 14, 2003